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Dated: June 21, 2005

Signature: 

(Alisa M. Haggemo)

Docket No.: 60680-1814
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Randall F. Alder et al.

Application No.: 10/707,675

Confirmation No.: 1674

Filed: December 31, 2003

Art Unit: 3679

For: **HOSE AND TUBE ASSEMBLY**

Examiner: **Dunwoody, Aaron M.**

PETITION UNDER 37 C.F.R. §1.144

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MS Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a petition under 37 C.F.R. § 1.144 requesting review of a restriction requirement made by the Examiner mailed February 14, 2005. Applicants submit that the restriction requirement is improper and has created an unwarranted delay in the prosecution of this application. Consequently, Applicants request that the Commissioner exercise his supervisory authority under 37 C.F.R. § 1.144 and withdraw this improper restriction requirement.

The Examiner asserts that Applicants' election *with traverse* of the invention elected was not found persuasive because "claim 1 recited 'at least one groove includes an opening and a base each having a predetermined width, said pre-determined width of said opening being generally less than said predetermined width of said base'; however, the elected species, Group 1, Figure 1, fails to meet this limitation." The specification, figures, and claims, however, are directed to the same inventive concept. Specifically, Figures 1 - 5, BRIEF SUMMARY OF THE INVENTION, DETAILED DESCRIPTION OF THE INVENTION, and ABSTRACT disclose and teach a groove that includes an opening and base each having a predetermined width and the predetermined width of the opening is generally less than the predetermined width of the base.

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Paragraph [0024] specifically states "any angle A *generally* less than about 90 degrees is contemplated by the present invention to result in predetermined width W1 of opening 46 being generally less than predetermined width W2 of base 48." Grooves 30 are shown in Figures 1 & 2 exactly as claimed the independent claims. The angle of the grooves in Figures 1 and 2 are shown generally *slightly* less than ninety (90) degrees as described and contemplated in the specification. The Examiner mistakenly asserts that the figures fail to meet this limitation. Additionally, the Examiner mistakenly asserts that this inventive concept when incorporated in the presented figures teaches patentably distinct species of the claimed invention.

Accordingly, Applicants request that the Commissioner exercise his supervisory authority under 37 C.F.R. §1.144 and withdraw this improper Election of Species requirement.

No fee is believed to be required in connection with this petition. However, if any fee is required, authorization is given to charge Deposit Account 18-0013.

I. BACKGROUND

This is a petition under 37 C.F.R. §1.144 requesting review of an Election of Species requirement made by the Examiner within the Office Action of February 14, 2005, which has been traversed within the Response to Election of Species Requirement filed on March 4, 2005 and made final within the Office Action mailed on March 22, 2005.

The Election of Species requirement of February 14, 2005 asserts an existence of the following independent and distinct inventions:

Group I, Figure 1;

Group II, Figure 2;

Group III, Figures 3 and 5; and

Group IV, Figure 4.

The Election of Species requirement further asserts that no claims are generic claims.

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A Response to Election of Species Requirement was filed on March 4, 2005. This Response elected with traverse the examination of the Group I invention.

In reply to the election and traversal made within the Response to Election of Species Requirement, the Office Action mailed on March 22, 2005 maintained the Election of Species requirement, making it FINAL on claim 11.

Accordingly, this petition pursuant to 37 C.F.R. §1.144 is proper.

For the reasons provided hereinbelow, the Election of Species requirement made within the Office Action of February 14, 2005 is respectfully traversed.

II. ARGUMENTS

"Since requirements for restriction under 35 U.S.C. 121 are discretionary with the Commissioner, it becomes very important that the practice under this section be carefully administered." M.P.E.P. §803.01.

Claims 1-19 were originally filed within the above-identified application. Claims 1 was originally filed as an independent claim and claims 2-10 were originally filed as claims dependent upon claim 1. Claim 11 was originally filed as an independent claim with no dependent claims. Claims 12 was originally filed as an independent claim and claims 13 – 19 were originally filed as claims dependent upon claim 12.

Based on review of the claims, Applicants elected Group I, *with traverse*. In view of the significant overlap between the claims of Groups I – IV, and the presence of generic claims, namely independent claims 1, 11, and 12, it is respectfully submitted that the Examiner will be required to search art related to the related groups as part of the analysis of the generic claims.

Moreover, it is respectfully submitted that the subject matter of the groups is sufficiently related that a thorough search for the subject matter of the species would encompass a search for the subject matter of the other species. See MPEP § 803, which states that "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent

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inventions.” (*Emphasis added*). This policy should apply in the present application to avoid unnecessary delay and expense to the Applicants and duplicative examination by the Patent Office.

Upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to other species in addition to the elected specie, provided that all claims to each additional species are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.

In particular, originally filed independent claim 1 is drawn to an assembly including a groove having an opening and a base where the width of the opening is generally less than the width of the base. Independent claim 12 is also drawn to an assembly including a groove having an opening and a base where the width of the opening is generally less than the width of the base.

A. THE OFFICE ACTION FAILS TO EXPLAIN HOW THE FIGURES ARE ASSOCIATED WITH THE GROUPS

As an initial matter, whereas Figures 1 - 5 listed in each of the Groups I - IV, the specification for the above-identified application describes Figures 1 - 5 within the BRIEF DESCRIPTION OF THE DRAWINGS as being directed to the present invention. As a result, the Election of Species requirement of February 14, 2005 fails to explain how and why Figures 1 - 5 are to be associated with any of the alleged Groups I - IV. Accordingly, the Election of Species requirement is improper and should be withdrawn at least for this reason.

B. THE BRIEF SUMMARY OF THE INVENTION STATES THAT THE INVENTION IS DIRECTED TO A HOSE ASSEMBLY HAVING A GROOVE WITH A PREDETERMINED WIDTH OF THE OPENING THAT IS GENERALLY LESS THAN THE PREDETERMINED WIDTH OF THE BASE

The Examiner asserts that Applicants' election with traverse of the invention elected was not found persuasive because "claim 1 recited 'at least one groove includes an opening and a base each having a predetermined width, said pre-determined width of said opening being generally less than said predetermined width of said base'; however, the elected species, Group 1, Figure 1, fails to meet this limitation. Therefore, claims 1 - 11 are not generic to all species."

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The Examiner is wrong on at least this point. First, the BRIEF SUMMARY OF THE INVENTION states: "[t]he **present invention** is directed to a hose assembly comprising a first member having an inner surface and a second member having an outer surface. The second member is partially received within the first member. One of the surfaces of the members includes at least one groove for receiving a portion of the other member. The groove includes an opening and base each having a predetermined width and the predetermined width of the opening is generally less than the predetermined width of the base." *Emphasis added.* Figures 1 - 5 in the specification include the *groove 30, 30'*.

C. THE BRIEF DESCRIPTION OF THE DRAWINGS SUPPORTS THAT ANY ANGLE LESS THAN 90 DEGREES IS CONTEMPLATED BY THE PRESENT INVENTION

The BRIEF DESCRIPTION OF THE DRAWINGS includes in paragraph [0007]: Figure 1 is a partial cross-sectional view of a hose assembly **of the present invention**. Further, paragraph [0024] states "**any angle A generally less than about 90 degrees is contemplated by the present invention** to result in predetermined width W1 of opening 46 being generally less than predetermined width W2 of base 48. Further, angle A of each side 50, 52 need not be the same, only less than about 90 degrees." Therefore, the Examiner is wrong in assuming that the grooves 30 in Figure 1 do not meet the inventive aspects of the claimed invention. The grooves 30 in Figure 1 are shown to be generally *slightly* less than ninety (90) degrees.

D. THE ABSTRACT STATES THAT THE ASSBMLY HAS A GROOVE WITH A PREDETERMINED WIDTH OF THE OPENING THAT IS GENERALLY LESS THAN THE PREDETERMINED WIDTH OF THE BASE

The ABSTRACT of the application also defines the grooves 30, 30'. "One of the two members has greater rigidity than the other member and at least one groove... The groove includes an opening and a base each having a predetermined width. The predetermined width of the opening is generally less than the predetermined width of the base." *Emphasis added.*

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E. FIGURES 1 & 2 SHOW A GROOVE *SLIGHTLY* LESS THAN 90 DEGREES

Third, grooves 30, 30' are shown in Figures 1 – 5 exactly as claimed in each independent claim. The angle of the grooves in Figures 1 and 2 are shown generally *slightly* less than ninety (90) degrees as described and contemplated in the specification.

III. CONCLUSION

In this regard, the Election of Species requirement found within the Office Action of February 14, 2005 failed to show that the claims presented for examination are directed to an invention distinct from and independent of the invention found within the originally filed claims 1 – 19.

Applicants request that the Commissioner exercise his supervisory authority under 37 C.F.R. §1.144 and withdraw this improper Election of Species requirement.

For the reasons provided herein, the Election of Species requirement made within the Office Action mailed on February 14, 2005 is respectfully traversed.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1814 from which the undersigned is authorized to draw.

Dated: June 21, 2005

Respectfully submitted,

By 

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